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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/589,512

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EXAMINER

CLEMENTE, ROBERT ARTHUR

ART UNIT

PAPER NUMBER

1797

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/589,512	<b>Applicant(s)</b> BARRIS ET AL.	
	<b>Examiner</b> ROBERT A. CLEMENTE	<b>Art Unit</b> 1797	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 02 November 2009.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 August 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>20091102</u> | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Terminal Disclaimer***

1. The terminal disclaimer filed on November 2, 2009 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of any patent granted on Application Number 11/883,690 has been reviewed and is NOT accepted.

2. The terminal disclaimer does not comply with 37 CFR 1.321(b) and/or (c) because:

It does not include a recitation that any patent granted shall be enforceable only for and during such period that said patent is commonly owned with the application(s) or patent(s) which formed the basis for the double patenting rejection. See 37 CFR 1.321(c)(3).

37 CFR 1.321 (c)(3) requires that a TD "Include a provision that any patent granted on that application or any patent subject to the reexamination proceeding shall be enforceable only for and during such period that said patent is commonly owned with the application or patent which formed the basis for the judicially created double patenting." The phrase "legal title" is not accepted as a statement declaring common ownership.

### ***Response to Arguments***

3. Applicant's arguments, see pages 6 and 7, filed November 2, 2009, with respect to the rejection(s) of claim(s) 1 - 5 under 35 U.S.C. 102(e) have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon

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further consideration, a new ground(s) of rejection is made in view of newly found prior art references.

The examiner agrees with applicant's arguments regarding the meaning of continuous, extruded fibers in the art. The examiner agrees that the cut fibers of Kahlbaugh cannot be considered continuous, extruded fibers, although any fibers can be considered continuous using the broad definition of continuous as extending without break. As discussed in the rejection below, however, it is equivalently known in the art to use either continuous or cut fibers to form nonwoven webs and filter media. Thus, the examiner considers it to be obvious to one of ordinary skill in the art to use continuous extruded fibers in the nonwoven filter media of Kahlbaugh.

4. In regard to applicant's request for a correction and/or clarification of the filing date, the applicant is directed to contact the filing receipts office at 571-272-4000.

#### ***Claim Rejections - 35 USC § 103***

5. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

6. Claims 1 - 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kahlbaugh (US 7,309,372) in view of US Patent Application No. 2003/0096549 to Ortega et al or US Patent No. 6,169,045 to Pike et al.

In regard to claim 1, Kahlbaugh teaches a filter medium that inherently could be used as "a first media stage" in a "crankcase ventilation filter" as these terms do not provide any structure to the media and the media of Kahlbaugh includes all of the

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structural limitations of claim 1 of the instant application. As disclosed in column 6 lines 42 - 52, the media of Kahlbaugh includes media fiber and a bicomponent fiber. As disclosed, the fibers are bonded together using the bicomponent fibers, thus the bicomponent fibers are bonded at spaced locations. Kahlbaugh discloses that an additional resin binder is optional, thus the media could be produced without any resin binder. As shown in Table 1 (below columns 15 and 16), the media can be used to filter crankcase blowby and the bicomponent fiber can have a diameter, or cross-sectional size, of at least 10 microns. As shown in the continuation of Table 1 (above columns 17 and 18), the media can be made with pore size that falls within the claimed range of 10 - 60 microns. The pore size is inherently measured in a linear direction. Applicant has not defined the claimed "X-Y direction" to be any specific direction. Thus, the calculated pore size of Kahlbaugh inherently can be considered to be measured in the X-Y direction. Neither the media nor the bicomponent fibers in Kahlbaugh are disclosed to be continuous, extruded fibers. Ortega discloses nonwoven fabrics, as discussed in paragraph [0003]. The fabrics are formed by a web of fibers that are bonded together at points of fiber-to-fiber contact. As disclosed in paragraph [0003], both continuous fibers and staple, or cut, fibers can be used to form the nonwoven fabric. As disclosed in paragraph [0016], bicomponent fibers can be used in the nonwoven fabric of Ortega. Pike teaches nonwoven fiber webs for use as filter media, as disclosed in column 1 lines 28 - 30. As disclosed in column 4 lines 24 - 34, the nonwoven webs are preferably formed from bicomponent fibers that are bonded together. As disclosed in column 6 lines 37 - 40, the fibers are formed as continuous fiber. As further disclosed in column 8

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lines 8 - 12, staple, or cut, fibers can also be equivalently used to form the nonwoven webs.

Thus, it would have been obvious to one of ordinary skill in the art at the time of the invention to substitute continuous, extruded fibers for the cut fibers in Kahlbaugh as suggested by Ortega or Pike because continuous and cut fibers are equivalently known to be useful in forming nonwoven webs. The substitution of one known fiber for another for the same purpose (forming a nonwoven web) is considered to be within the scope of a skilled artisan absent clear evidence showing otherwise.

In regard to claim 2, as disclosed in column 22 lines 9 - 11, the media of Kahlbaugh can be formed as a tubular construction.

In regard to claim 3, as disclosed in column 22 lines 14 - 20 of Kahlbaugh, a pleated cylindrical media, which forms a tubular media, is imbedded in end caps. Thus, the media is positioned in extension between first and second end caps.

In regard to claim 4, as discussed above, the media of Kahlbaugh can be made without any binder resin. Thus, the media inherently includes no more than 3%, by weight, added binder resin.

In regard to claim 5, as discussed above, Kahlbaugh includes bicomponent fibers in the media. In the combination the bicomponent fibers can be provided as continuous, extruded fibers.

7. Claims 1 - 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gieseke (US 6,290,739) in view of Kahlbaugh and Ortega or Pike as applied to claims 1 - 5 above.

Gieseke teaches a crankcase ventilation filtration assembly (50), as best shown in figures 2 and 4. The assembly (50) includes a housing (52). The housing (52) includes a gas flow inlet arrangement (58), a gas flow outlet arrangement (60), and a liquid drain outlet arrangement (62). The media filter (66) can be considered a first media stage and forms a serviceable crankcase ventilation filter operably positioned within the housing (52). Gieseke does not disclose forming the media filter (66) with media having the structural limitations of claim 1 of the instant application. As discussed above in section 6, the combination of Kahlbaugh and Ortega or Pike teaches a filter media having all of the structural limitations of claims 1 - 5 of the instant application. Kahlbaugh forms the primary reference in this combination and discloses a filter media capable of use as a crankcase ventilation media filter, as shown in Table 1.

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Gieseke to include a media filter including a media of the type of Kahlbaugh and Ortega or Pike since this media is known to be effective as a media for filtering crankcase blowby.

### ***Double Patenting***

8. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir.

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1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

9. Claims 1 - 6 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1 - 3, 5, and 12 of copending Application No. 11/883,690 in view of Ortega (US 2003/0096549) or Pike (US 6,169,045). Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 1 - 3, 5, and 12 of the '690 application disclose all of the structure of claims 1 - 6 of the instant application except for continuous fibers being bonded at spaced locations. As discussed above in section 6, Ortega and Pike both teach using continuous and cut fibers as equivalents in forming nonwoven webs where the fibers are bonded together. Thus, it would have been obvious to one of ordinary skill in the art to form the filter media of the '690 with continuous fibers that are bonded together because these fibers are equivalently known to be used in forming nonwoven webs.

This is a provisional obviousness-type double patenting rejection.

10. Claims 1 - 6 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 3, 4, 6, 7, and 10 of copending Application No. 11/884,743 in view of Ortega or Pike. Although the



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conflicting claims are not identical, they are not patentably distinct from each other because claims 1, 3, 4, 6, 7, and 10 of the '743 application disclose all of the structure of claims 1 - 6 of the instant application except for continuous fibers being bonded at spaced locations. As discussed above in section 6, Ortega and Pike both teach using continuous and cut fibers as equivalents in forming nonwoven webs where the fibers are bonded together. Thus, it would have been obvious to one of ordinary skill in the art to form the filter media of the '690 with continuous fibers that are bonded together because these fibers are equivalently known to be used in forming nonwoven webs.

This is a provisional obviousness-type double patenting rejection.

### ***Conclusion***

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to ROBERT A. CLEMENTE whose telephone number is (571)272-1476. The examiner can normally be reached on M-F, 7:00-3:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Marcheschi can be reached on (571) 272-1374. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Robert A Clemente/  
Examiner, Art Unit 1797